

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:

Hiroyuki MUKAI et al.

Patent No.: 6,951,722

Issued: October 4, 2005

For: METHOD FOR AMPLIFYING NUCLEIC ACID SEQUENCE

Date: April 19, 2007

SUBMISSION OF PRIOR ART UNDER 37 CFR 1.501

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, Mail Stop Post Issue
Crystal Plaza Two, Lobby, Room 1B03
Arlington, Virginia 22202

Sir:

Applicants herewith submit in the above-identified patent the following prior art (including copies thereof, with the exception of US patents) which are pertinent and applicable to the patent and are believed to have a bearing on the patentability of at least claim 1 thereof:

US Patent No. 5,538,848, LIVAKE et al., July 23, 1996, APPLIED BIOSYSTEMS DIVISION, PERKIN-ELMER CORP.

US Patent No. 5,652,126, LACKEY et al., July 29, 1997, GEN-PROBE INCORPORATED

WO 96/40901, GEN-PROBE INCORPORATED, December 19, 1996

WO 96/15270, HYBRIDON, INC., June 27, 1996

WO 00/56877, TAKARA SHUZO CO., LTD., September 28, 2000 (Abstract)

Ikunoshin KATO, "ICAN-hou ha PCR wo koemasuka?", Kagaku, December 2000, 55:20-21

For the record, the patentability of the patent claims in view of the above list of prior art references was considered by the examiner in continuation application no. 10/973,919, which has the same claims as issued in the above-identified US Patent 6,951,722. The examiner in U.S. application no. 10/973,919 has indicated by initialing PTO SB/08a forms, copies of which are attached, that the examiner has considered the references and has not deemed them material to the patentability of the same claims as issued in U.S. Patent 6,951,722. The sole rejection in U.S. application number 10/973,919 is a 35 U.S.C. §101 statutory double patenting rejection as claiming the same invention as the claims in U.S. Patent 6,951,722. Accordingly, the validity of the claims of U.S. Patent 6,951,722 in view of the above-listed prior art references is effectively affirmed by the examiner in U.S. application no. 10/973,919.

Respectfully submitted,

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